

REMARKS

Claims 1-5, 8-12, and 15-21 are pending. Claims 6, 7, 13, and 14 were previously cancelled. Claims 20 and 21 are cancelled without prejudice. Claims 1 and 8 have been amended. No new matter has been added.

35 U.S.C. § 102(E) REJECTIONS

Claims 1, 8, and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Collins III et al., U.S. Pub. No. 2005/0184387.

The Examiner is respectfully directed to independent Claim 1, which, as amended, recites that an embodiment of the present invention is directed towards:

A light emitting diode package comprising:
a ceramic substrate for mounting a light emitting diode, said substrate defining a cavity with a vertical ceramic sidewall, wherein said cavity is shaped to focus light in a predetermined direction; and
a metallic coating on a portion of said ceramic substrate for reflecting light in a predetermined direction.

Independent Claim 8 recites similar limitations. Claims 15-19 are dependent on Claim 8, and recite further features of the claimed embodiments.

The rejection suggests that Collins III describes every element of the claimed embodiments recited in Claims 1 and 8. Applicants respectfully disagree, and assert that Collins III fails to teach or describe a cavity with a vertical ceramic sidewall, as claimed.

The rejection, in reference to now-cancelled Claim 20, suggests Collins III describes a cavity having a vertical sidewall, and references Figure 5 of Collins III. However, Applicants contend that Collins III does not show a vertical sidewall. Specifically, the sidewall depicted in Figure 5 of Collins III has a definite slope from the top of the package to the bottom of the

package. Moreover, none of the embodiments depicted by Collins III reveal a vertical sidewall. Therefore, Collins III does not anticipate or render obvious the embodiments recited in Claims 1 and 8.

With reference to Claim 19, the rejection states that Collins III fails to teach "the optically transparent material forming a concaved layer," and makes reference to Abe, an uncited reference. Applicants require clarification of this rejection, as it appears to acknowledge that Collins III does *not* anticipate the embodiment recited in Claim 19. Applicants respectfully request that this rejection be restated or withdrawn.

Therefore, Applicants respectfully contend that Collins III fails to anticipate or render obvious the embodiments of the present invention recited in Claims 1 and 8. As such, Applicants contend that Claims 1 and 8 are in condition for allowance. Accordingly, Applicants assert that Claims 15-19, dependent on Claim 8, also overcome the basis for rejection as being dependent on allowable base claims.

35 U.S.C. § 103(A) REJECTIONS

Claims 2-5 and 9-12 are rejected under 35 U.S.C. 103(a) as being obvious over Collins III et al., U.S. Pub. No. 2005/0184387, in view of Ishinaga, U.S. Patent No. 6,355,946.

The Examiner is respectfully directed to independent Claim 1, reproduced above. Claim 8 recites similar limitations. Claims 2-5 are dependent on Claim 1, and recite further features of the claimed embodiments. Claims 9-12 are dependent on Claim 8, and recite further features of the claimed embodiments.

The rejection suggests that Collins III, in combination with Ishinaga, teaches every element of the claimed embodiments. Applicants have reviewed the cited art, and respectfully disagree. Applicants assert that Collins III, alone or in combination with Ishinaga, fails to teach a ceramic substrate defining a cavity with a vertical ceramic sidewall, as claimed.

As stated above, Applicants contend that Collins III fails to teach or describe a vertical sidewall. Ishinaga does not remedy this defect in Collins III. Specifically, every embodiment depicted in Ishinaga shows a cavity with sloped walls (see, e.g., Figs. 1, 3-5, 9, and 10).

Therefore, Applicants respectfully contend that Collins III, alone or in combination with Ishinaga, fails to anticipate or render obvious the embodiments of the present invention recited in Claims 1 and 8. As such, Applicants contend that Claims 1 and 8 are in condition for allowance. Accordingly, Applicants assert that Claims 9-12, dependent on Claim 8, overcome the basis for rejection as being dependent on allowable base claims.

Moreover, the rejection suggests the combination of Ishinaga and Collins III. Applicant respectfully contends that the combination of these references is not suggested by the teachings of either Ishinaga or Collins III. The semiconductor device of Ishinaga is proposed as a backlight for a non-circular push button of an electronic device (col. 2, ln. 10-13). The ceramic substrate of Collins III is proposed as part of a metal oxide varistor (§ 6), used for transient voltage suppression. Applicant respectfully contends that one of ordinary skill in the art, having the teachings both Ishinaga and Collins III available, would not be

motivated to combine the semiconductor device of Ishinaga with the ceramic substrate of Collins III, in a way so as to render obvious the claimed embodiments of the present invention.

The rejection suggests that the test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. While Applicants agree that this is part of the statutory test for obviousness, Applicants do not agree that this is the complete test. From MPEP § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicants note that:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

Applicants further note:

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Finally, there must be "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references," *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

The only motivation to combine Collins III and Ishinaga provided by the rejection is that "different shapes would provide different illumination patterns and would increase the

aesthetic appearance based on the application of the device," (p. 5, ¶ 2). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so," *In re Mills* at 682. Applicants again respectfully request that some citation for the motivation be provided, or that this rejection be withdrawn.

Conclusion

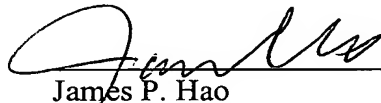
In light of the above-listed amendments and remarks, Applicants respectfully request allowance of the remaining Claims.

The Examiner is urged to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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